

REMARKS

The last Office Action has been carefully considered.

It is noted that claim 16-17, 19-20, 22-26 and 28 are rejected under 35 U.S.C. 103(a) over the patent to Forderer in view of the patent to Dorner.

Claims 21 and 27 are rejected under 35 U.S.C. 103(a) in view of the patent to Forderer in view of the patent to Raddle.

At the same time the Examiner indicated that claim 18 is allowed.

The Examiner's indication of the allowance of claim 18 has been gratefully acknowledged.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended claim 16, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Before the analysis of the prior art, it is believed to be advisable to analyze claim 16 in detail, with reference numerals utilized in the drawings.

Claim 16, the broadest claim on file, defines a power tool which has the following elements: at least one handle 10,

said handle comprising at least one grip 12, 72, 106 part that is firmly connected to and firmly held at a mounting part 16, 70, 110 by at least one elastic,

vibration-damping element located between the grip part 14, 24, 52, 108 and the mounting part,

wherein the grip part is affixed to a housing 60 via the mounting part which is screwed into the housing 12, 72, 106,

so that the elastic element is mounted to the housing through the mounting part and also mounted to the grip part, and

wherein the connection between the grip part 12 and the mounting part 16 by means of the elastic element 14 is secured by at least one movable retaining 14, 24, 52, 108 element

that prevents a separation of the grip part 12, 72, 106 from the housing 60 if the elastic element 20, 22, 28, 64, 112, is damaged and that ensures control of the power tool via the grip part 12, 72, 106 at all times.

Turning now to the references and particularly to the patent to Forderer, it can be seen that this reference deals with an antivibration device for mounting between a motor unit and a handle unit. In this reference the handle 9 is connected through the elastic, vibration-damping element with a plug 31 shown in Figures 2 and 3. The plug 31 is inserted in an end section 30 of the vibration-damping element 6, to widen the vibration-damping element 6 radially and thereby to press the vibration-damping element 6 with its outer contour with a receiving groove 21 directly form-lockingly into a corresponding inner contour with a holding rib 25 of a housing 2 as shown in Figures 2 and 3 and disclosed in column 3, lines 59-65. The vibration-damping element is thereby mounted directly on the housing 2 and not via a mounting part as defined in claim 16.

The objective of the present invention is to reliably prevent a loosening of the grip part from the housing in the event of a damage to the elastic element, as explained on page 1 in lines 18-31 of the specification and defined in claim 16.

In the device disclosed in the patent to Forderer there is a direct connection between the plug 31 and the handle 9 with the interposition of only the vibration-damping element 6. The vibration-damping element can be destroyed in the points B1 and B2 shown in the enclosed drawings, so that no securing through a retaining element is provided here. Breaking at any of the breaking points B1 and B2 leads to the separation of the handle 9 from the housing 2, since the vibration-damping element 6 is a bearing connecting part. Since the patent to Forderer does not provide any hint or suggestion for this feature, a person skilled in the art at the time of the invention would not arrive from the teaching of the patent to Forderer at the present invention as defined in claim 16.

The patent to Dorner which was applied in combination with the patent to Forderer discloses a vibration damping element 20, 21, 22, 23, which is substantially similar to the vibration damping element disclosed in the patent to Forderer.

The patent to Dorner discloses a power tool with a grip part 4 that is connected through the vibration damping element 20, 21, 22, 23, a pin 55, and sleeves 41, 50, 60 with the motor/machine as shown in Figure 2. The vibration damping elements 20, 22, 23 are accommodated in a cap 41. The cap 41 is pressed from outside onto the vibration

damping element 20, 22, 23. The pin 55 is located in a sleeve 50 which is pressed into the vibration damping element 20, 22, 23 and thereby provides a radial widening of the vibration-damping element 20, 22, 23. Moreover, a side of the vibration damping element 20, 22, 23, is pressed directly form-lockingly into a corresponding inner contour 26a of the grip part 4 and is additionally widened radially by a sleeve 60. The vibration damping elements 20, 21, 22, 23, in addition to the dampening functions also have additionally a bearing function (by the form-locking connection) for mounting the grip part 4 on the cap 41.

The patent to Dorner discloses no securing element, for securing the bearing connection. Therefore, it can not be avoided that in the case of failure of the vibration-damping element 20, 21, 22, 23 the grip part 4 is released from the cap 41 and thereby from the motor system 2'.

In the patent to Dorner a direct connection between the pin 55 and the grip part 40 without interposition of the vibration-damping element 20, 22, 23 can not be controlled. In particular, the damping element 20, 21, 22, 23 when damaged can be torn off at the breaking points B1 and B2 as shown in the enclosure 2, so that no securing through securing or retaining element is provided. Each of the breaking points B1 and B2 leads to the situation that the grip part 4 is released from the motor

system 2', since here the vibration-damping element 20, 21, 22 and 23 is a bearing connecting part.

Furthermore, the device disclosed in the patent to Dorner does not achieve the main objective of the present invention to reliably prevent a loosening of the grip part from the machine housing in the event of damage to the elastic element.

Since neither the patent to Forderer nor the patent to Dorner provide any suggestions for the feature of the securing by a securing or a retaining element in the sense of the applicant's invention as defined in claim 16, the present invention can not be considered as obvious from the combination of the references.

In order to arrive at the applicant's invention from the teachings of these references, the references have to be fundamentally modified, and in particular by including into them the new features which were currently defined in claim 16 and were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not provide any hint or suggestion for such modifications.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushma and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art could .

It is therefore believed that claim 16 should be considered as patentably distinguishing over the art and should be allowed together with other claims which depend on it.

Applicant also added claims 33-39 which define additional features that patentably distinguish the present invention from the prior art as well.

The features of claim 33 is disclosed on page 2, line 7-10. The feature of claim 34 is disclosed on page 11, lines 7-8 and shown in Figure 8.

The feature of claim 35 is disclosed on page 11, line 7-9. The feature of claim 36 is disclosed on page 11, lines 22-23. The feature of claim 37 disclosed on page 1, lines 19-23

The feature of claim 38 is disclosed on page 11, lines 10-11. The feature of claim 39 is disclosed on page 11, lines 25-27. In the event of a maximum deviation of a grip part 106, a direct contact between the screw head 132 and the grip part 106 is prevented by the flange 150 and thereby a vibration transmission is avoided.

The grip part 106 in the event of damage to the elastic element 108 is connected non-releasably with the mounting part 110, since falling of the grip part 106 through the screw head 132 can be prevented.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

/ Michael J. Striker /

Michael J. Striker
Attorney for Applicants
Reg. No. 27233